

REMARKS

Claims 29—48 are pending in the application. Claims 33, 34, 39-42, 47, and 48 are currently withdrawn. Claims 29-32, 35-38, and 43-46 are currently examined. No claims have been amended, no new claims have been added, and no claims are presently cancelled.

In view of the following Remarks, allowance of all the pending claims is requested.

Rejections under 35 U.S.C. §112, 1st Paragraph

The Examiner has rejected claims 29-32, 35-38, and 43-46 under 35 U.S.C. §112, 1st paragraph as allegedly failing to comply with the enablement requirement. Applicants traverse this rejection for at least the reason that the specification describes the subject matter in such a way as to enable one of ordinary skill in the art to make and use the invention without undue experimentation. See *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). The Examiner is reminded that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. See *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). We further note that there are many factors that are to be considered when determining whether any necessary experimentation is undue, including: (A) The breadth of the claims, (B) The nature of the invention, (C) The state of the prior art, (D) The level of one of ordinary skill, (E) The level of predictability in the art, (F) The amount of direction provided by the inventor, (G) The existence of working examples, and (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure. The examiner's analysis must consider or address evidence related to these factors, and any conclusion of non-enablement must be based on the evidence as a whole. See, MPEP 2165.01(a) and *In re Wands*, 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407 (Fed. Cir. 1988). The examiner has failed to consider any of the above factors and therefore has not set forth a proper prima facie case of non-enablement.

The Examiner alleges that certain claim language is not "supportive [sic] in the specification..." May 2011 Office Action, pg. 4. The Examiner provides no further substantive analysis to support this conclusory statement, much less analysis based on any of the factors

discussed above. For at least this reason, the Examiner has not performed the analysis necessary to formulate a proper non-enablement rejection.

The Examiner alleges that “the applicant refers to big sections of the specification to support each limitation of the claims and the applicant is advised to refer to a specific section in the specification to support all the limitations of the pending claims...” *Id.* From this statement, it is clear that the Examiner has not engaged in any analysis to determine whether the specification describes the subject matter in such a way as to enable one of ordinary skill in the art to make and use the invention without undue experimentation. Rather, the Examiner has merely deemed the examples of supporting passages provided in the July 1999 Preliminary Amendment to be “too big,” which is not a valid reason for finding a lack of enabling disclosure.

The Examiner is reminded that the burden is on the Examiner to perform the proper analysis relating to enablement of claims. See e.g., MPEP §2164.04 (“In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)”). The size or breadth of the portions of the specification cited by Applicants as examples of enabling passages is therefore irrelevant to whether the specification provides enabling disclosure for the claims.

For at least the reasons set forth above, the Examiner has failed to make a *prima facie* case of non-enablement for claims 29-32, 35-38, and 43-46. Therefore, the rejection of claims 29-32, 35-38, and 43-46 is improper and must be withdrawn.

CONCLUSION

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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Respectfully submitted,

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